REMARKS

Claims 13 – 14, 23 – 24, and 37 – 38 are amended to add the word "claim" for consistency with the other dependent claims. Claim 41 is amended to correct a typographical error. More specifically, claim 41 is amended to depend from claim 40.

Claims 1 – 43 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Boyer et al. (U.S. Pat. No.: 6,202,923). Specifically, the Examiner stated:

> Boyer discloses a method comprising: receiving prescription information identifying a requested medical item (bar code); creating a substitution reference list in response to said prescription information, said substitution reference list identifying at least one of said requested medical item and an equivalent item (see figure 2 and column 6, lines 21 – 67); and automatically outputting dispensing information related to a selected medical item on said substitution reference list in response to the application of substitution rules in a database (column 6, line 50).

It is respectfully submitted that the Examiner has misconstrued the teachings of Boyer. More specifically, Boyer fails to teach "creating a substitution reference list" and/or "automatically outputting dispensing information related to a selected medical item on said substitution reference list in response to the application of substitution rules in a database".

"Substitution reference list" is discussed within paragraph 35 of the specification for the instant invention. Paragraph 35 states:

> After receiving the prescription information and identifying the medical item, the server 12, for example, may apply one or more substitution rules to the prescription information to produce a substitution reference list. If an equivalent medical item is not permitted to be dispensed (e.g., the physician has issued a dispense as written order), the substitution reference list will identify only the requested (i.e., prescribed) medical item. If the substitution of an equivalent medical item is permitted, the substitution reference list may contain the requested medical item and one or more equivalent medical items that are within the integrated pharmacy system 10.

"Substitution rule" is discussed within paragraph 19 of the specification for the instant invention. Paragraph 19 states:

> The substitution rules may be, as described more fully below, rules embodying knowledge about the dispensing system hardware configurations, product availability, expiration date, cost, profit potential, inventory management, and workflow efficiencies. Substitution rules may also embody pharmaceutical equivalencies as defined by the pharmacy or a regulatory agency.

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In contrast, Boyer merely discloses that adjudication may be completed. More specifically, Boyer teaches that a prescription 2 is entered into a data entry workstation 5. (See Figure 1 and column 6, lines 21 – 24.) The data entry workstation 5 communicates with the pharmacy management system 81 (See Figure 6 and column 6, lines 32 – 37.) The pharmacy management system then completes adjudication. Boyer states "adjudication is determining whether the insurance company or HMO will allow the patient to use this drug or whether another drug must be substituted." (Column 6, lines 40 - 43.) After the adjudication is completed, the data entry workstation 5 creates a new data record or updates an existing data record. (Column 6, lines 48 – 49.) Additionally, the data entry workstation 5 transmits information to the filling workstation 6 and the checking workstation 25. (Column 6, line 49 – 51.)

It is respectfully submitted that adjudication differs from the creation and use of a substitution reference list as recited by the claimed invention. Adjudication is not the same as "creating a substitution list." Accordingly, Boyer fails to teach the creation of a substitution reference list and/or the application of substitution rules to dispense a selected medical item.

Claims 1 – 43 also stand rejected under 35 U.S.C. § 102(b) as being anticipated by Peoples (U.S. Pat. No.: 6,620,761). Specifically, the Examiner stated:

> Peoples teaches a method comprising: receiving prescription information (bar code NDC) identifying a requested medical item; creating a substitution reference list in response to said prescription information (see column 6, lines 15 – 25), said substitution reference list identifying at least one of said requested medical item and an equivalent item; and automatically outputting dispensing information related to a selected medical item on said substitution reference list in response to the application of substitution rules in a database (column 6, line 24).

It is respectfully submitted that the Examiner has misconstrued the teachings of Peoples. Peoples fails to teach or disclose creating a substitution reference list in response to prescription information and/or automatically outputting dispensing information related to a selected medical item on the substitution reference list in response to substitution rules.

In contrast, Peoples is merely directed to a device and method "for converting product-specific identification numbers associated with bar code indicia on pharmaceutical products to an industry standard identification number." (See abstract.) More specifically, Peoples is directed to converting bar codes of differing formats into a standardized 11-digit NDC number. (See Figure 1, column 4, lines 64 – 66.) After a bar code is scanned, it is converted into an input string, which is then standardized into the NDC format. (Column 5, lines 58 – 63.) If the first character in the scanned string is a non-zero integer, the first five characters in the scanned string may be replaced with a replacement string. (Column 6, 1 – 4.) The replacement string may then be replaced itself by a substitution string. (Column 6, lines 15 – 21.)

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Peoples states: "[t]his substitution is made for the purpose of converting a particular source's bar code to that source's NDC number." Accordingly, it is respectfully submitted that Peoples fails to teach or disclose creating a substitution reference list in response to prescription information and/or automatically outputting dispensing information related to a selected medical item on the substitution reference list in response to substitution rules.

Claims 1, 4, 16, and 30 are independent claims. Claim 1 recites, "creating a substitution reference list" and "automatically outputting dispensing information related to a selected medical item on said substitution reference list in response to the application of substitution rules in a database." As discussed above, both Boyer and Peoples fail to teach "creating a substitution reference list" and/or "automatically outputting dispensing information related to a selected medical item on said substitution reference list in response to the application of substitution rules in a database". Thus, it is believed that claim 1 is allowable over Boyer and allowable over Peoples. Accordingly, it is respectfully requested that the rejections of claim 1 pursuant to 35 U.S.C. §102(b) in view of Boyer and pursuant to 35 U.S.C. §102(b) in view of Peoples be withdrawn.

Claims 2 – 3 depend from allowable claim 1. Thus, for the same reasons discussed above in conjunction with claim 1, it is believed that claims 2 – 3 are allowable over Boyer and allowable over Peoples. Accordingly, it is respectfully requested that the rejections of claims 2 – 3 pursuant to 35 U.S.C. §102(b) in view of Boyer and pursuant to 35 U.S.C. § 102(b) in view of Peoples be withdrawn.

Claim 4 recites "automatically applying substitution rules from a database to said received information" and "automatically outputting dispensing information related to a selected medical item based on the application of said substitution rules." As discussed above, both Boyer and Peoples fail to teach the use of substitution rules and/or outputting dispensing information based on the application of substitution rules. Thus, it is believed that claim 4 is allowable over Boyer and allowable over Peoples. Accordingly, it is respectfully requested that the rejections of claim 4 pursuant to 35 U.S.C. §102(b) in view of Boyer and pursuant to 35 U.S.C. § 102(b) in view of Peoples be withdrawn.

Claims 5 – 15 depend from claims 1 and 4. Thus, for the same reasons discussed above in conjunction with claims 1 and 4, it is believed that claims 5 – 15 are allowable over Boyer and allowable over Peoples. Accordingly, it is respectfully requested that the rejections of claims 5 – 15 pursuant to 35 U.S.C. §102(b) in view of Boyer and pursuant to 35 U.S.C. § 102(b) in view of Peoples be withdrawn.

Claim 16 recites, "automatically applying substitution rules from a database to said received information" and "automatically outputting stock location information based on the application of said substitution rules." As discussed above, Boyer fails to teach the use of substitution rules and/or outputting

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stock location information based on the application of substitution rules. Claim 16 further recites, "retrieving a stock bottle based on said stock location information" and "dispensing from said retrieved stock bottle." It is respectfully submitted that figure 2 and column 6, lines 21 – 57 of Boyer and column 6, lines 15 – 25 of Peoples, as cited by the Examiner, fail to teach retrieving and dispensing from a stock bottle. Thus, it is believed that claim 16 is allowable over Boyer and allowable over Peoples. Accordingly, it is respectfully requested that the rejections of claim 16 pursuant to 35 U.S.C. §102(b) in view of Boyer and pursuant to 35 U.S.C. § 102(b) in view of Peoples be withdrawn.

Claims 17 – 29 depend from claim 16. Thus, for the same reasons discussed above in conjunction with claim 16, it is believed that claims 17 – 29 are allowable over Boyer and allowable over Peoples. Accordingly, it is respectfully requested that the rejections of claims 17 – 29 pursuant to 35 U.S.C. §102(b) in view of Boyer and pursuant to 35 U.S.C. § 102(b) in view of Peoples be withdrawn.

Claim 30 recites, "automatically applying substitution rules from a database to said received information" and "automatically outputting information to an automated dispensing device based on the application of said substitution rules." As discussed above, Boyer and Peoples fail to teach the use of substitution rules and/or outputting information based on the application of substitution rules. Claim 30 further recites, "automatically dispensing in response to said output information." It is respectfully submitted that figure 2 and column 6, lines 21 – 57 of Boyer and column 6, lines 15 - 25, as cited by the Examiner, fail to teach automatically dispensing in response to output information. Thus, it is believed that claim 30 is allowable over Boyer and allowable over Peoples. Accordingly, it is respectfully requested that the rejections of claim 30 pursuant to 35 U.S.C. §102(b) in view of Boyer and pursuant to 35 U.S.C. § 102(b) in view of Peoples be withdrawn.

Claims 31 – 43 depend from claim 30. Thus, for the same reasons discussed above in conjunction with claim 30, it is believed that claims 31 – 43 are allowable over Boyer and allowable over Peoples. Accordingly, it is respectfully requested that the rejections of claims 31 – 43 pursuant to 35 U.S.C. §102(b) in view of Boyer and pursuant to 35 U.S.C. § 102(b) in view of Peoples be withdrawn.
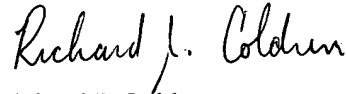
Although the Office's basis for rejecting all the claims seems to be directed only to the language recited within claim 1, Applicants have made a good faith effort to illustrate that each independent claim is allowable individually. Additionally, although Applicants have argued that dependent claims 2 – 3, 5 – 15, 17 – 29 and 31 – 43 are allowable due to their dependence from allowable base claims 1, 4, 16, and 30, respectively, it is also believed that the Office has failed to provide sufficient basis for the rejection of each of the dependent claims. Accordingly, should the Office determine in a subsequent action that one

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or more independent claims is not allowable, Applicants respectfully request clarification as to which portions of the cited art anticipate each dependent claim so that a proper response may be formulated.

Applicants have made a diligent effort to place the claims in condition for allowance. Accordingly, a Notice of Allowance for claims 1 – 43 is respectfully requested. If the Examiner is of the opinion that the instant application is in condition for disposition other than through allowance, the Examiner is respectfully requested to contact applicants' attorney at the telephone number listed below so that additional changes may be discussed.

Respectfully submitted,

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Dated: 14 April 2005

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